

The Rejections under 35 U.S.C. § 102

The rejections of claims 53-89 under 35 U.S.C. § 102, as being anticipated by Miki (abstract of JP 53065865) or Anner (abstract of CH 538460) are respectfully traversed.

The Office Action recites three structural formulae allegedly from the cited references and allegedly within the claimed scope.

The first two structures do not fall within the literal scope of the instant claims. Each of these structures contain an OH group at the 17 position (i.e., the top most position on the 5-membered ring). This position corresponds to the group R¹⁷ of formula (I) of applicants' claim 53. The literal definition of the R¹⁷ group in claim 53 does not include the possibility of an OH group. Because these structures do not satisfy a definition for the R¹⁷ group in applicants' claims, they do not meet every element of any of applicants' claims and the reference(s) disclosing these compounds cannot anticipate the instant claims on the basis of such disclosure.

The third structure recited in the Office Action does fall within the formula (I) definition of claim 53 (although not some of the dependent claims). However, applicants do not see where this compound is actually disclosed in the cited abstracts or any of the cited references. The structures in the abstracts print-out provided with the Office Action do not include such structure. Further, the full text of the JP 53-65865 and CH 538460 references have been obtained and reviewed, as has GB 1570597 also cited in the print-out provided with the Office Action, (copies of these references are attached). No evidence is seen for the third structure recited in the Office Action, for a generic structure encompassing this structure or of a compound named 7-methyl-estra-1,3,5(10)-triene-3,16-diol. All of the chemical formulae shown in each of these references relate to compounds with an Oacyl, OR or OH group at the 17 position, thus, outside the literal scope of applicants' formula (I). The GB reference discloses 16 β -ethylestradiol as a starting material and, possibly, the JP reference also discloses this compound. But this compound is not the diol of the formula shown in

the Office Action with the 7-methyl group and the OH in the 16 position. Also, 16 β -ethylestradiol is a 3,17 diol compound with the ethyl group in the 16 position, so it is not within the scope of the instant claims.

Applicants, therefore, respectfully submit that the references fail to support a disclosure for the stated third compound and there is no evidence that these references disclose any compound within the scope of applicants' instant claims. Thus, the references do not meet all elements of the claims and cannot anticipate the claims and the rejection under 35 U.S.C. § 102 should be withdrawn.

It is noted that certain dependent claims are distinguished for even further reasons. But applicants' will reserve additional comments on such distinctions until such time as may become necessary.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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